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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,754	04/09/2004	John Edward O'Neill	JEO-00101	1868
28960 7590 12/27/2006 HAVERSTOCK & OWENS LLP			EXAMINER	
162 NORTH W	OLFE ROAD	•	MENDIRATTA, VISHU K	
SUNNYVALE, CA 94086			ART UNIT	PAPER NUMBER
			. 3711	
		·		
SHORTENED STATUTOR	Y PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE	
3 MO	NTHS	12/27/2006	PAPER	

## Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)				
Office Assistant Communication	10/821,754	O'NEILL, JOHN EDWARD				
Office Action Summary	Examiner	Art Unit				
·	Vishu K. Mendiratta	3711				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be tim ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 02 Oc	ctober 2006.					
	action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits						
closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
·	, , , , , , , , , , , , , , , , , , , ,					
Disposition of Claims						
4)⊠ Claim(s) <u>1-12,33 and 34</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
· · · · · · · · · · · · · · · · · · ·	5) Claim(s) is/are allowed.					
·	6)⊠ Claim(s) <u>1-12,33,34</u> is/are rejected.					
7) Claim(s) is/are objected to.	') Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election requirement.					
Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
	11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119						
		(1)				
<ul> <li>12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents</li> <li>2. Certified copies of the priority documents</li> <li>3. Copies of the certified copies of the priori application from the International Bureau</li> <li>* See the attached detailed Office action for a list of</li> </ul>	have been received. have been received in Application ty documents have been received (PCT Rule 17.2(a)).	on No d in this National Stage				
Attachment(s)    Notice of References Cited (PTO-892)   Notice of Draftsperson's Patent Drawing Review (PTO-948)   Information Disclosure Statement(s) (PTO/SB/08)   Paper No(s)/Mail Date	4)  Interview Summary Paper No(s)/Mail Da 5)  Notice of Informal Pa	(PTO-413) te				

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#### **DETAILED ACTION**

### Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12 rejected under 35 U.S.C. 102(b) as being anticipated by Weiss (4093237).

Claims 1,7,12: Weiss teaches a game board (Fig.2) comprising a plurality of game pieces, a plurality of first game pieces designated by a first type (Kings), a plurality of second game pieces designated by a second type (pawn), a plurality of third type game pieces designated by a third type (bishop), a plurality of forth type game pieces designated by a forth type (rooks), a plurality of fifth game pieces designated by a fifth type (knight), a plurality of sixth game pieces designated by a sixth type (queens), wherein a all four queens are different in colors and further the game board comprising outer (peripheral) and inner squares.

The limitation "associated with" is treated as "rule for playing" and does not further limit the apparatus as claimed.

Claims 2,8: Weiss game board teaching all game piece types to be configured in different (K,Q,R,B,Kt,P).

Claims 3,9: Weiss game board having grid of squares (Fig.2) at least 8x8.

Claim 4: Weiss teaches outer perimeter and inner area of squares (Fig.2).

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Claims 5,10: Weiss teaches a die as a randomizer means (4:38).

Claim 6,11: Weiss game pieces are capable of being designated as tree types.

Designations are intended use and not further limiting apparatus claims.

## Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 4. Claims 33,34 rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss. Weiss teaches all limitations except that it does not teach first type of game pieces in a specific shape. Examiner takes the position that game piece shapes are configured according to personal preferences that are aesthetically pleasing. The art area of game boards is an amusement art area and in order to attract players it would have been obvious to configure game pieces aesthetically pleasing. One of ordinary skill in art at the time the invention was made would have suggested configuring specific shapes for game pieces to attract potential players.

#### Response to Arguments

5. Applicant's arguments with respect to claims are not persuasive. <u>The limitation</u> "associated with" is treated as "rule for playing" and does not further limit the apparatus as claimed.

Examiner takes the position that Weiss teaches four sets of chess game pieces and all sets are in different color. King pieces = 1<sup>st</sup> type, Pawn pieces = second type, Bishop

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pieces = third type, Rook pieces = fourth type, Knight pieces = fifth type, Queen pieces = sixth type, 1<sup>st</sup> queen piece = purple color, 2nd queen piece = red color, 3<sup>rd</sup> queen piece = blue color, 4<sup>th</sup> queen piece = green color.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VKM December 11, 2006 Vishu K Mendiratta Primary Examiner Art Unit 3711